Modified PTO/SB/33 (10-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number Q68142	
	Application Number 10/031,698	Filed January 23, 2002
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	First Named Inventor Tatsuki SHIOTA	
	Art Unit 1617	Examiner Shengjun WANG

WASHINGTON OFFICE
23373
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Applicant requests review of the rejection in the above-identified application, which has been twice been rejected, once finally, on the same ground. No amendments are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

☑ I am an attorney or agent of record.
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Signature

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July 16, 2008
Date

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Tatsuki SHIOTA, et al.

Docket No: Q68142

Appln. No.: 10/031,698

Group Art Unit: 1617

Confirmation No.: 8252

Examiner: Shengjun WANG

Filed: January 23, 2002

For: CYCLIC AMINE CCR3 ANTAGONIST

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated April 16, 2008, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Claims 7 and 11, directed to methods of treatment of certain CCR3-associated conditions, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rogers et al., U.S. Patent No. 6,166,015.

According to the Examiner, Rogers et al. teaches pyrrolidine derivatives-CCR-3 receptor antagonists with a general formula I, wherein Z may be N, A may be –NCO-, B is alkylene with 1-4 carbon inclusive wherein one of the carbon atoms may optionally be replaced by $-N(R_4)-$,

-$NR_2C(O)NR_3$-[1], etc., Ar^1 and Ar^2 may be aromatic or heteroaromatic rings, wherein the heteroaryl means monovalent monocyclic or bicyclical aromatic radical of 5 to 10 ring atoms including pyridyl, pyrrolyl, pyrimidinyl etc. However, the Examiner recognizes Rogers et al. does teach that "n" in the claimed compounds is 0. The Examiner further asserts that Rogers et al. teaches that the compounds are useful pharmaceutical agents for treating CCR-3 receptor associated disorders, particularly, those eosinophil-mediated inflammatory diseases. The Examiner admits that Rogers et al. does not teach expressly the employment of the claimed compounds for treating eosinophilic disorders.

Nonetheless, the Examiner concludes that it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to use the compounds recited in the present claims for treating the eosinophilic disorders, because the compounds recited in the present claims are homologs of the Rogers et al. compounds or are structurally similar to the Rogers et al. compounds.

For the following reasons, the rejection is improper and/or overcome.

All of the Rogers et al. compounds are 3-methyl pyridines. In contrast, the claimed compounds lack the essential 3-methyl group of the Rogers et al. compounds.

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[1] Rogers et al. does not teach that B is alkylene with 1-4 carbon inclusive wherein one of the carbon atoms may optionally be replaced by -$NR_2C(O)NR_3$-. Rather, -$NR_2C(O)NR_3$- is one of the substituents represented by A. (*see Rogers, page 3, lines 12-13 and page 4, lines 7-9)*

Applicant submits that with n defined as 0, none of the compounds of Rogers et al. can be considered a homolog of the presently claimed compounds. Thus, it is improper for the Examiner to rely on the law relating to homologs.

In addition, the cases that hold that a genus that encompasses a species makes the species *prima facie* obvious are not relevant. This is because the Rogers et al. genus does not include the claimed compounds. The Examiner does not explain why one of ordinary skill in the art would modify the compounds of Rogers et al. to remove the essential methyl group. Rather, the Examiner merely states that the modified compounds would be expected to have the same activity as the compounds of Rogers et al., because the compounds are "structurally similar."

However, Applicant has submitted an executed Declaration Under 37 C.F.R. §1.132 signed by Tatsuki Shiota.[2]

In the declaration, the Declarant explains that the compounds of the present invention are not taught or suggested by the compounds of Rogers et al., because the removal of one -CH_2- group from a carbon chain changes the shape of the molecule, such that one of ordinary skill in the art would not expect the modified compounds to retain the activity of the original compounds. Thus, the Declarant concludes that it is unexpected and surprising that the compounds of the present invention actually show potent CCR3 inhibitory activity.

[2] The Declaration is signed January 17, 2008 and was filed January 28, 2008.

Nonetheless, in the Office Action mailed April 16, 2008, the Examiner maintains the rejection, stating that the compounds are homologs, and, thus, the Declaration is not persuasive. As pointed out above, the compounds are not homologs. However, more importantly, the nomenclature is not what is important. What matters is that the Declarant addresses the physical difference between the compounds and, based on scientific evidence, offers a professional opinion that retention of activity after removal of the CH_2 group is unexpected. The Office action ignores the professional opinion of the Declarant and substitutes therefore the unsupported opinion of the Examiner. This is noting more than the impermissible use of hindsight.

Based on the evidence of record, there is no motivation to make the suggested change of removing a methyl group, and, furthermore, it is unexpected that the compounds recited in the present claims have CCR-3 inhibitory activity. Therefore, use of the compounds to inhibit CCR-3 receptor activity, and to treat and prevent diseases involving CCR-3 receptor activity, is not obvious in light of Rogers et al.

Accordingly, the Panel is requested to reconsider and remove this rejection.

Respectfully submitted,

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